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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,216	12/01/2003	Ryouichi Ochi	Y1929.0100	9809

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EXAMINER

SAFAIPOUR, BOBBAK

ART UNIT	PAPER NUMBER
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2631

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,216

Applicant(s)

OCHI ET AL.

Examiner

Bobbak Safaipoor

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/21/06, 12/01/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statements submitted on 7/21/2006 and 12/01/2003 have been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 2, and 4-8** are rejected under 35 U.S.C. 102(e) as being anticipated by

Vertaschitsch et al (United States Patent # 6,976,217 B1).

Consider claim 1, Vertaschitsch et al clearly show and disclose a telephone control method for a portable information processing terminal, which comprises extracting prescribed hardware information from hardware information of said portable information processing terminal by an information processor of said portable information processing terminal, and performing telephone operation control on the basis of the hardware information thus extracted (col. 2, lines 64 - col. 3, lines 9; The present invention includes a PDA having an integrated telephone device that communicates user data and actions from the telephone user interface

Art Unit: 2631

program to the telephone device control program via a communications link between the first processor and the second processor and controls the operation of the integrated telephone device via the telephone device control program according to the user data and actions communicated).

Consider **claim 2**, Vertaschitsch et al clearly show and disclose a telephone control method for a portable information processing terminal, which comprises extracting prescribed hardware information from hardware information of said portable information processing terminal by an information processor of said portable information processing terminal (col. 2, lines 64 - col. 3, lines 9; The present invention includes a PDA having an integrated telephone device that communicates user data and actions from the telephone user interface program to the telephone device control program via a communications link between the first processor and the second processor and controls the operation of the integrated telephone device via the telephone device control program according to the user data and actions communicated), and controlling prescribed hardware associated with the prescribed hardware information on the basis of the hardware information thus extracted and telephone control information of said portable information processing terminal (col. 5, lines 1-6; The PDA has interactive hardware that performs functions such as maintaining calendars, phone lists, and at least one voice or audio related function so as to be configured for use with cellular telephone capabilities of the PDA).

Consider **claim 4**, and as **applied to claim 2 above**, Vertaschitsch et al clearly show and disclose hardware information thus extracted is a light amount state of a display portion of said portable information processing terminal (col. 3, lines 59-67; The PDA comprises a display screen 230 for display of Operating System prompts, buttons, icons, application screens, and other data), the telephone control information is information indicating whether a telephone call

Art Unit: 2631

state is possible or not (figure 6; col. 7, line 55 - col. 8, line 35; The phone control program has operations for configuring the mobile radio device 340 to make a call, answer an incoming call, or is pre-programmed to continue ringing or other notification until a lost call signal is received from the phone control application indicating that there is no longer an incoming call) and the control of the prescribed hardware is a light amount control of the display portion (col. 3, lines 59-67; The PDA comprises a display screen 230 for display of Operating System prompts, buttons, icons, application screens, and other data).

Consider **claim 5**, and **as applied to claim 2 above**, Vertaschitsch et al clearly show and disclose hardware information thus extracted is a list of applications being operated of said portable information processing terminal (col. 5, lines 12-17; The software includes a phone user interface, operating system, and other application, such as word processors, spreadsheets, or databases), the telephone control information is a call notification (figure 6; col. 7, line 55 - col. 8, line 35; The phone control program has operations for configuring the mobile radio device 340 to make a call, answer an incoming call, or is pre-programmed to continue ringing or other notification until a lost call signal is received from the phone control application indicating that there is no longer an incoming call), and the control of the prescribed hardware is a control of finishing at least one application (col. 5, lines 24-28; The processing unit runs applications, including the operating system and other user applications as directed by user inputs).

Consider **claim 6**, and **as applied to claim 2 above**, Vertaschitsch et al clearly show and disclose portable information processing terminal has a voice processing device, the hardware information thus extracted indicates the state of the voice processing device (col. 10, lines 20-28; Included in the software programming of the microprocessor is a software module for

Art Unit: 2631

implementing transferring audio and voice data), the telephone control information indicates whether a telephone call state is possible or not (figure 6; col. 7, line 55 - col. 8, line 35; The phone control program has operations for configuring the mobile radio device 340 to make a call, answer an incoming call, or is pre-programmed to continue ringing or other notification until a lost call signal is received from the phone control application indicating that there is no longer an incoming call), and the control of the prescribed hardware is a control for transmitting voice data to the voice processing device (col. 10, lines 20-28; Included in the software programming of the microprocessor is a software module for implementing transferring audio and voice data).

Consider **claim 7**, Vertaschitsch clearly show and disclose a telephone control program product embodied on a storage portion of a portable information processing terminal and comprising code that, when said program product executed, cause said portable information processing terminal to perform a telephone control method comprising:

a first step of extracting prescribed hardware information from hardware information of said portable information processing terminal by an information processor of said portable information processing terminal (col. 2, lines 64 - col. 3, lines 9; The present invention includes a PDA having an integrated telephone device that communicates user data and actions from the telephone user interface program to the telephone device control program via a communications link between the first processor and the second processor and controls the operation of the integrated telephone device via the telephone device control program according to the user data and actions communicated), and

a second step of comparing the prescribed hardware information thus extracted with the recorded telephone operation processing corresponding to the hardware information of said

Art Unit: 2631

portable information processing terminal, and carrying out the telephone operation control corresponding to the prescribed hardware information by the information processor (col. 5, lines 1-6; The PDA has interactive hardware that performs functions such as maintaining calendars, phone lists, and at least one voice or audio related function so as to be configured for use with cellular telephone capabilities of the PDA)..

Consider **claim 8**, Vertaschitsch clearly show and disclose A telephone control program product embodied on a storage portion of a portable information processing terminal and comprising code that, when said program product executed, cause said portable information processing terminal to perform a telephone control method comprising:

a first step of extracting prescribed hardware information from hardware information of said portable information processing terminal by an information processor of said portable information processing terminal (col. 2, lines 64 - col. 3, lines 9; The present invention includes a PDA having an integrated telephone device that communicates user data and actions from the telephone user interface program to the telephone device control program via a communications link between the first processor and the second processor and controls the operation of the integrated telephone device via the telephone device control program according to the user data and actions communicated), and

a second step of comparing the hardware information thus extracted and the telephone control information of said portable information processing terminal with the recorded control information associated with the hardware corresponding to the telephone control information of said portable information processing terminal, and carrying out the control of the hardware corresponding to the telephone control information of said portable information processing

Art Unit: 2631

terminal (col. 5, lines 1-6; The PDA has interactive hardware that performs functions such as maintaining calendars, phone lists, and at least one voice or audio related function so as to be configured for use with cellular telephone capabilities of the PDA).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Vertaschitsch et al (United States Patent # 6,976,217 B1) in view of Jones, Jr. (United States Patent #5,974,334).**

Consider **claim 3**, and **as applied to claim 1 above**, Vertaschitsch et al clearly disclose the claimed invention except for wherein the hardware information thus extracted is information on mounting/demounting of a cradle of said portable information processing terminal, and the telephone operation control is an off-hook operation or on-hook operation.

In the same field of endeavor, Jones, Jr. clearly shows and disclose as known in the art a PDA 10 having a removable handset that is positionable in both a substantially flush and a non-flush configuration, which includes a base 12 with a handset 14 removably secured within a cradle 16 recessed within the base (Jones, Jr.: figure 1; col. 3, lines 9-14). Furthermore, Jones, Jr. discloses a tubular shape adapter 38 that is configured to be removably secured to the base 12. The PDA has opposing first and second end portions 40a and 40b. The first end portion 40a is configured to receive the second end portion 26b of the handset 14 and removably secure the handset therein. When the adapter 38 is removably secured to the base 12 and the handset 14 is removably secured within the adapter first end portion 40a, the handset is positioned such that a user can easily grasp and remove it from the adapter 38 for use (Jones, Jr.: figure 4; col. 4, lines 30-50).

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Jones, Jr. into the system of Vertaschitsch et al to provide have a multi-positional PDA handset configuration.

Art Unit: 2631

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(U.S. Patent # 6,944,782 B2) disclose a **Magnetic strip reader with power management control for attachment to a PDA device.**

(U.S. Patent Application Publication #2003/0011628 A1) disclose a **Method and apparatus for a portable digital assistant device having improved data input.**

(U.S. Patent Application Publication #2003/0006998 A1) disclose a **Portable data entry device with host PDA.**

8. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bobbak Safaipoor whose telephone number is (571) 270-1092. The Examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

Art Unit: 2631


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Bobbak Safaipour
B.S./bs

August 4, 2006


RAFAEL PEREZ-GUTIERREZ
PRIMARY EXAMINER

8/7/06